

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<sup>1</sup> Applicants have been unable to locate a copy of the videotape from *IPLX v. Infinite Pictures* listed on page 4 of 4 of the Form. A copy was submitted and made of record in related application Serial No. 08/516,629 (now U.S. Patent No. 5,990,941), which is the parent of the related copending application cited herein. The Examiner is respectfully requested to check the related application files for the cited videotape. The Examiner is respectfully requested to advise applicants if it can be found, and if so, to consider it and make it of record herein.

In accordance with recently revised Rule 1.98(a)(2), a copy of the specification (including the claims) and the drawings of the cited application is enclosed. The references listed in the attached Form PTO/SB/08A include the references of record in the cited related application that were not previously made of record herein.

Applicants wish to further advise the USPTO as follows. Litigation is presently ongoing between Ford Oxaal and the assignee of the present application, Internet Pictures Corp. (IPIX). Mr. Oxaal has alleged infringement by IPIX of two U.S. patents issued to him: Nos. 5,903,782 (the '782 patent) and 6,157,385 (the '385 patent). The '782 patent is asserted in *Ford Oxaal v. Interactive Pictures Corp. et al.*, No. 99-CV-0802 (N.D.N.Y., filed May 20, 1999). The '385 patent is asserted in *Ford Oxaal v. Internet Pictures Corp.*, No. 00-CV-1863 (N.D.N.Y., filed December 5, 2000). IPIX has denied Oxaal's infringement allegations and counterclaimed for declarations of patent invalidity. For the Examiner's reference, a copy of the Court's docket sheets for each of these cases is attached.

In above-mentioned Civil Action No. 99-CV-0802, IPIX has moved the Court for a summary judgment that claim 1 of the '782 patent is invalid. In support of that motion, IPIX has asserted that Mr. Oxaal publicly used the invention of claim 1 of the '782 patent in the United States in April of 1993. IPIX further asserts that Oxaal placed the same invention on sale at least by August 18, 1994, by offering, at least by this date, to provide photographic images produced using the claimed invention of claim 1 of the '782 patent for use in promotional materials, made available to the public in January 1995, for the interactive artwork "Lovers Leap."<sup>2</sup> IPIX's motion for summary judgment

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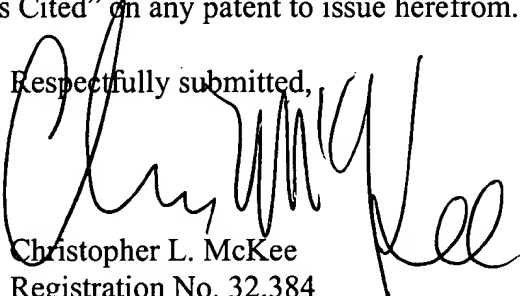
<sup>2</sup> Materials pertaining to the "Lovers Leap" interactive artwork exhibit are listed in the attached Form PTO/SB/08A, and a copy of the listed materials is submitted herewith.

remains pending. Mr. Oxaal has opposed IPIX's motion and denies IPIX's assertions of barring public use and on-sale activity.

The motion package for IPIX's summary judgment motion was filed with the Court under seal, and is subject to a confidentiality protective order entered by the Court. Should the Examiner desire further information concerning IPIX's summary judgment motion, or concerning any other aspects of the ongoing litigations, he is respectfully requested to so indicate. IPIX will endeavor to provide any requested additional information, within the constraints of the confidentiality requirements imposed by the Court.

Applicants submit the above information so that the USPTO may, in the first instance, determine any materiality thereof. It is respectfully requested that the information be formally considered during the prosecution of this application, and that the listed references be made of record herein and appear among the "References Cited" on any patent to issue herefrom.

Respectfully submitted,

  
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